

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/136,483	08/19/98	KUMAR	S N19.12-0016

PETER S DARDI  
WESTMAN CHAMPLIN & KELLY  
SUITE 1600 INTERNATIONAL CENTRE  
900 SECOND AVENUE SOUTH  
MINNEAPOLIS MN 55402-3319

IM51/0519

EXAMINER

MARCHESCHI, M

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 05/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

*Peter Dardi 7/19/98 6/6*

<b>Advisory Action</b>	Application No. <b>09/136,483</b>	Applicant(s) <b>Kumar et al.</b>
	Examiner <b>Michael Marcheschi</b>	Group Art Unit <b>1755</b>

**THE PERIOD FOR RESPONSE: [check only a) or b)]**

- a)  expires three months from the mailing date of the final rejection.
- b)  expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on May 4, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- The proposed amendment(s):

- will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- will not be entered because:
  - they raise new issues that would require further consideration and/or search. (See note below).
  - they raise the issue of new matter. (See note below).
  - they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

- Applicant's response has overcome the following rejection(s):  
\_\_\_\_\_

- Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
all the references teach alumina particles having a size within the claimed range. Applicants argue that some of the references do not teach alumina particles. (see attached)

- The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

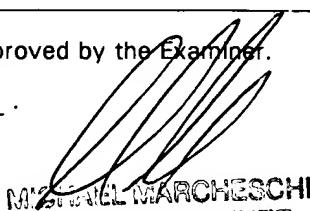
- For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: 1-3 and 5-22

- The proposed drawing correction filed on \_\_\_\_\_  has  has not been approved by the Examiner.
- Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Other

  
**MICHAEL MARCHESSI**  
 PRIMARY EXAMINER

Art Unit: 1755

**ATTACHMENT TO ADVISORY ACTION:**

After careful review of these references, **all** are directed to making alumina particles and therefore no distinction is seen to exist (i.e. the title of Arai et al. is **the production of metal oxides**). The examiner acknowledges the declaration by Nobuyuki Kambe, but this declaration **does not** show any evidence rebutting the obviousness rejections. The declaration appears to state that the synthesis of the references is not capable of producing nanoparticles as defined by the claimed invention. **This is not convincing because all of the references teach alumina particles having sizes within the claimed range (overlapping ranges) and therefore a prima facie case of obviousness is established (see *In re Malagari* as set forth in all the rejections).** It is apparent that the claimed invention is directed to alumina particles having a distinct size range and the examiner does not see any patentable subjected matter with respect to said size range.



MICHAEL MARCHESSI  
PRIMARY EXAMINER